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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,574	04/01/2004	Shao Xiang Lu	LOREAL 3.0-038/OA 04156	1233
530 7590 07/21/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER SOROUSH, ALI	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 07/21/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,574	Applicant(s) LU, SHAO XIANG	
	Examiner ALI SOROUGH	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 and 43-64 is/are pending in the application.
- 4a) Of the above claim(s) 5,7-11,13,14,16-19,30,32,33 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,12,15,20-29,31,34,35,39-41 and 43-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05082009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/07/2009 has been entered.

Status of the Claims

Claims 5, 7-11, 13, 14, 16-19, 30, 32, 33, and 36-38 are withdrawn, claim 42 is cancelled, and claims 1, 43 and 61 are currently amended. Therefore, claims 1-4, 6, 12, 15, 20-29, 31, 34, 35, 39-41 and 43-64.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. The rejection of claims 1-4, 6, 12, 15, 20-29, 31, 34, 35, 39-41 and 43-64 under 35 U.S.C. 103(a) as being unpatentable over Caes et al. (International Application Published Under the PCT WO 00/49997 A2, Published 08/31/2000) in view of Kashihara et al. (International Application Published Under the PCT WO 02/092047, Published 11/21/2002) **is maintained**.

Applicant Claims

Applicant claims a cosmetic composition comprising a gelled block copolymer and a silicone elastomer powder. Applicant further claims a method for care, make-up or treatment of keratin material.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Caes et al. teach, "The subject-matter of the present invention is transfer-free composition comprising (a) at least one of di-block, tri-block, multi-block and/or radial block copolymer and optionally (b) a film former or a mixture film formers ... Cosmetic and pharmaceutical compositions of the invention result in a film with very good retention, good transfer resistant properties, and which does not migrate over time. The

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compositions have cosmetic properties which are improved in relation to those of the 'transfer free' products of the prior art." (See abstract). "In preferred embodiment, the copolymer film former of the present invention is chosen from the class of Kraton® rubbers ..." (See page 4, Lines 1-2). "Each molecule of Kraton® rubber is said to comprise block segments of styrene monomer units and rubber monomer and/or co-monomer units. The most common structure for Kraton® triblock copolymer is linear A-B-A block type styrene-butadiene-styrene, styrene-isoprene-styrene, or styrene-ethylenebutylene-styrene." (See page 4, Lines 15-19). "The block copolymer film former may preferably be formulated by dissolving the block copolymer in a hydrocarbon solvent ... In a preferred embodiment, the block copolymer film former is formulated by dissolving the block copolymer in isododecane or a light paraffinic solvent." (See page 5, Lines 3-9). "For example, for cosmetic foundations, the block copolymer film former or block copolymer film former mixtures may preferably be used in an amount from less than about 1% to about 30% by weight ..." (See page 6, Lines 9-12). "In a further embodiment of the invention, the cosmetic product is a water-in-oil emulsion or an oil-in-water emulsion." (See page 7, Lines 27-28). "Other compositions known in the art that are intended to leave a film on the skin or hair may also be added to the composition of the invention, including emollients and other ingredients usually employed in the field envisaged. These added ingredients may include gels, oils, waxes, preservatives, thickner agents, solvents, surfactants, emollients and other ingredients that when incorporated into the formulation stay on top of the skin and do not strongly adhere to the substrate." (See page 8, Lines 5-11). "Other emollients that may be preferably used

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in the compositions of the invention include ... dimethicone ..." (See page 8, Lines 20-21). "In a preferred embodiment, emollients are present at a concentration of about 0.5% to about 8% by weight." (See page 8, Lines 25-27). "The composition of the invention may further include the fatty substances, and or waxes which are usually employed in the field of application envisaged or other formulation aids." (See page 8, Lines 29-30). "Representative fatty substances include silicones in esterified or unesterified liquid form or esterified solid form, such as behenate dimethicone, nonsilicone fatty substances, such as oils, pastes and vegetable, mineral, animal and/or synthetic waxes." (See page 9, Lines 8-11). "It is also possible to add to the composition of the invention any customary additive from the field of compositions to be applied in any cosmetic formulation including cosmetic foundations, eye liners, lipsticks, mascaras, eyeshadows, concealers, lotions or any other mentioned applications of the invention such as: thickening agents, for example clays, or organoclays, silicas, cellulose derivatives; hectorites; synthetic polymers such as an acrylic polymer or an associative polymer of the polyurethane type; gums and in particular xanthum gum; spreading agents; dispersants; preservatives, in particular water soluble preservatives; antifoaming agents; wetting agents; UV-screening agents; perfumes; fillers; cosmetic or pharmaceutical active agents; moisturizers; vitamins and derivatives thereof; biological materials and derivatives thereof." (See page 9, Lines 24-32 and page 10, Lines 1-2). "The active functional ingredients may include pigments, UV filters, moisturizing agents, fragrance, pharmaceutical agents and other active or functional ingredients known in the cosmetic or pharmaceutical arts." (See page 10, Lines 18-21).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Caes et al. lacks a teaching of a composition comprising silicone elastomer powder as the cosmetic powder. This deficiency is cured by the teachings of Kashihara et al.

Kashihara et al. teaches a cosmetic composition comprising silicone elastomer powder, water soluble polymer, water soluble humectant, a nonvolatile silicone compound, and an aqueous carrier. (See title and abstract). Particularly, useful herein as solid silicone powders are fine particles of a silicone rubber of which the particles have a composite structure that consists of a spherical or globular particle of a cured silicone rubber and coating layer of the polyorganosilsesquioxane resin. (See page 4, Lines 11-19). Commercially available solid silicone elastomer powders highly useful herein include vinyl dimethicone/methicone silsesquioxane crosspolymer. (See page 5, Lines 31-32). The silicone elastomer provides for improved coverage of wrinkles, fine lines, and pores while providing good feel to the skin. (See page 1, Lines 9-11).

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine the teachings of Caes et al. with Kashihara et al. One would have been motivated to do so because Caes et al. teach that other compositions known in the art that are intended to leave a film on the skin or hair may also be added to the composition of the invention. Kashihara et al. teaches that the silicone elastomer powder provides for improved coverage of wrinkles, fine lines and pores. Therefore, it would have been obvious to one

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of ordinary skill in the art to combine Kashihara et al. with Caes et al. to improve the cosmetic of Morrison. With regard to the dimethicone being a swelling agent, this use is not considered a further limitation of the claim because the claim recites all the components of the composition. The intended use of the dimethicone is not given patentable weight. With regard to the block polymer having a hard segment concentration of 15 to 30%, glass transition temperature of at least 60C, and soft segment glass transition temperature of no higher than room temperature are implicit to the tri-block copolymer styrene-ethylenebutylene-styrene. With regard to the ratio of the silicone elastomer powder to gelled block polymer, the instantly claimed ratios would have been obvious to one of ordinary skill in the art. It would have been within the skill of an artisan to adjust the concentrations of the cosmetic powder and gelled block polymer through routine experimentation to arrive at the instantly claimed ratios. For the foregoing reasons the instant invention would have been obvious to one of ordinary skill in the art at the time of the instant invention.

Response to Applicant's Arguments

Applicant's argue that Kashihara et al. teach a non-emulsifiable composition whereas Caes et al. and the instant invention are directed to emulsions, therefore the combination of Caes et al. and Kashihara et al. would not be obvious to one of ordinary skill in the art at the time of the instant invention. Applicant's arguments have been fully considered but found not to be persuasive. The Examiner has solely relied on the teachings of Kashihara et al. to show that it would be obvious to add a silicone elastomer powder to a cosmetic composition. Silicone elastomer powder is a well

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known component of cosmetic compositions both emulsions and nonemulsions and therefore one of ordinary skill in the art would expect success in adding silicone elastomer powder to an emulsion such as taught by Caes et al. Furthermore, Applicant's argument that prior art publications must be evaluated in their entirety and therefore there would be no motivation to combine the prior art references, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references make obvious to one of ordinary skill in the pertinent art. For the foregoing reasons the instant rejection of claims 1-4, 6, 12, 15, 20-29, 31, 34, 35, 39-41 and 43-64 under 35 U.S.C. 103(a) is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616